



UNITED STATES DEPARTMENT OF COMMERCE
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VS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/894,824	08/29/97	FRIEBE	R BAYER9930-WC

IM22/1018
SPRUNG KRAMER SCHAEFER & BRISCOE
660 WHITE PLAINS ROAD
4TH FLOOR
TARRYTOWN NY 10591-5144

EXAMINER

MOORE, M

ART UNIT	PAPER NUMBER
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1712

15

DATE MAILED:

10/18/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/894,824

Applicant(s)

Friebe et al.

Examiner

Margaret Glass Moore

Group Art Unit

1712



☒ Responsive to communication(s) filed on Aug 26, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1 to 6 and 8 to 13 is/are pending in the application.

Of the above, claim(s) 11 and 12 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 to 6, 8 to 10 and 13 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1712

1. Upon reconsideration and in view of applicants' amendments and remarks, the rejection under 35 U.S.C. 103 over Wakabayashi et al. in view of Kimura et al. has been withdrawn. While the Examiner does not agree with applicants' arguments directed to the "beloved vinyl resin" of Wakabayashi et al., patentees are specific as to the presence of an organozirconium compound in the curable composition. There is no suggestion or motivation to use the specifically claimed component (e) in the composition of Wakabayashi et al.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 to 6, 8 to 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiller et al. in view of Sattlegger et al. for reasons of record.

Applicants' traversal of this rejection is not persuasive, nor is it clearly understood by the Examiner. First applicants note the differences between amine/oxime curing sealants and alkoxy curing sealants. However Schiller et al. are not limited to amine/oxime curing sealants, as applicants are well aware. Their response draws attention to the alkoxysilane curing agent taught by Schiller et al. Applicants' response fails to address the basic premise for the obviousness of the claims as argued by the Examiner, i.e. the obviousness of adding an adhesion promoter to the composition of Schiller et al.

Applicants' general comments on what one might expect if an alkoxy silane is added to the composition of Schiller et al. appear to be based on speculation and not fact. Furthermore it is not clear how this speculative effect would render the claims unobvious since any effect on shelf life would not render the composition itself inoperable or unfavorable. Since applicants fail to provide clear and convincing arguments for the unobviousness of the instant claims, this rejection is maintained.

Art Unit: 1712


4. Claim 1 is objected to because of the following informalities: the definition of "n" should be 0, 1 or 2 and not 0.1 or 2. Appropriate correction is required.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication should be directed to Margaret G. Moore at telephone number (703) 308-4334.

Any **official** documents (after final rejection) can be faxed to (703) 305-3599. All other **official** faxes should be sent to (703) 305-5408. Please do not send any informal communication or proposed amendments to this number.


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
October 17, 1999